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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,254	12/20/1999	TERRY P. MAHONEY	10992003-1	3404

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EXAMINER

MILLER, MARTIN E

ART UNIT PAPER NUMBER

2623

DATE MAILED: 07/08/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

SC

Office Action Summary

Application No.

09/468,254

Applicant(s)

MAHONEY ET AL.

Examiner

Martin Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed June 12, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on June 12, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/468254 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. Applicant's amendment filed June 12, 2003 has been entered into the record. Accordingly, claims 1, 20 and 22 have been amended.

Response to Arguments

3. Applicant's arguments with respect to claims 1-22 in light of Hecht have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's arguments filed June 12, 2003 with respect to Yamaguchi have been fully considered but they are not persuasive. Applicant argues, "In fact, in a video-conferencing system, documents are generally presented in a separate window from an electronic source and activation based on waving a document would not have been obvious (or even desirable) at all." However, Yamaguchi teaches, "an infrared sensor for detecting the movement of a hand is attached to a camera for shooting materials for presenting a document", so that a document can be presented to the users. The examiner is relying upon the teaching of Yamaguchi to prove that it is well-known in the business office environment to use motion-activated image capture devices for presentation of documents. In response to applicant's argument that Yamaguchi fails

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to teach waving a document to activate an image capture device, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant's specification calls this a minor adjustment (p. 5, ll. 13-23) and Yamaguchi proves using a motion detector to activate an image capture device is a minor adjustment as admitted by the applicant.

Claim Objections

5. Claim 5 is objected to because of the following informalities: claim by uses the phrase "by a copying" which probably should be -- by copying". Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3-17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zdybel, JR. et al., (hereinafter Z686), US 5486686, further in view of Yamaguchi et al., (hereinafter Yamaguchi), US 6400392 B1.

As per claim 1, Z686 teaches:

creating (col. 6, ll. 23-25) and storing (via filename, col. 6, ll. 59-62) the electronic document (element 32, fig. 2a);

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placing a mark (glyph, col. 8, ll. 47-50) on the hardcopy (col. 8, ll. 52-65, col. 9, ll. 27-37), the mark containing identification information of the electronic document (col. 10, ll. 23-24) and processing information of the electronic document (ASCII, DDL, PDL digital encodings, col. 7, ll. 1-37, col. 9, ll. 39-44);

viewing the hardcopy by an image capture device to capture an image of the hardcopy document (input scanner, fig. 2b, element 12, col. 9, ll. 46-51);

decoding ("machine readable" is equivalent to decoding, col. 8, ll. 44-47, col. 9, ll. 40-45, and col. 10, ll. 17-25) the mark from the image captured by the image capture device to determine identification information (fig. 2b, element 136) of the electronic document (col. 6, ll. 16-21) and processing information (appearance related, col. 9, ll. 58-67);

retrieving (recovered, col. 9, ll. 47-49) the electronic document based on the determined identification information of the electronic document; and

processing the electronic document according to the identification information (col. 10, ll. 1-13).

However, Z686 does not teach activating an image capture device via motion detection. But Yamaguchi teaches:

viewing the hardcopy by an image capture device ("camera for shooting a document", col. 18, l. 56) to capture an image of the hardcopy document wherein the image capture device is activated by waving ("movement of a hand", which clearly would be holding the document) a copy of the hardcopy (col. 15, ll. 22-25, figure 20) document in front of the image capture device (camera, col. 15, l. 24 and figure 27);

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It would have been obvious to one of ordinary skill in the art to use the document sensing technology of Yamaguchi's system (col. 5, l. 64-col. 6, l. 1) in the system of Z686 to alleviate users from using a flat bed scanner and using more efficient and up-to-date scanner technology. Furthermore, Z686 appreciates that flat bed scanners or facsimile devices are not the only devices that can be used to collect and reproduce a document image (col. 6, ll. 44-55). Additionally, Z686 acknowledges that input scanners have no mechanisms for recovering data related to the document other than what can be ascertained from the documents appearance (col. 8, ll. 25-30), so accordingly any image capture device can be used such as the document pickup camera (see Yamaguchi, fig. 27).

As per claim 3, Z686 teaches:

wherein the step of placing a mark on the hardcopy is performed by creating the mark at the time of creation of the electronic document fig. 2a, 105) and wherein the hardcopy, with the mark, is printed from the electronic document (fig. 2a, 15 via 46 and 48).

As per claim 4, Z686 teaches:

wherein the step of placing a mark is performed by a printer that prints a digital mark on the hardcopy document. (col. 8, ll. 47-50).

As per claim 5, Z686 teaches:

wherein the step of placing a mark is performed by a copying the hardcopy having a mark to create another hardcopy with the mark ("further augmented" col. 10, ll. 56-67).

As per claim 6, Z686 teaches:

wherein the mark is a bar code (fig. 1b, col. 8, ll. 52-55).

As per claim 7, Z686 teaches:

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wherein the mark is a two dimensional bar code (fig. 1b, col. 8, ll. 55-60).

As per claim 8, Z686 teaches:

wherein the step of processing the document includes retrieving the document for viewing (col. 6, ll. 23-25, personal computers typically have a monitor).

As per claim 9, Z686 teaches:

wherein the step of processing the document includes the step of mailing the document by electronic mail (fig. 2a, 42, fig. 2b, element 41, col. 7, ll. 18-24).

As per claim 10, Z686 teaches:

wherein the step of processing the document includes the step of the printing the document (fig. 2a, elements 46, 48, 16and 15).

As per claim 11, Z686 teaches:

wherein the step of processing the document includes the step of making a copy of the electronic document (fig. 2b, element 54).

As per claim 12, Z686 teaches:

wherein the mark is machine readable code formed on a substrate on which the hardcopy is printed (col. 8, ll. 49-50, printed on the hardcopy).

As per claim 13, Z686 teaches:

wherein the machine readable code is formed using font pattern modification including one of a half-tone screen (screen frequency, col. 9, ll.64) , inter-character spacing modification (col. 8, ll. density), and dithering patterns (rotation of halftoned images, col. 9, l. 64).

As per claim 14, Z686 teaches:

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wherein the machine readable code is formed on a particular location (predetermined region) in the hardcopy document (col. 9, ll. 27-37).

As per claim 15, Z686 teaches:

wherein the mark is a digital mark (digital data form, col. 9, l. 47).

As per claim 16, Z686 teaches:

wherein the step of placing a mark is performed by a printing press (printing processes, col. 11, l. 5) that prints the mark during bulk printing (col. 10, l. 62-col. 11, ll. 9). Z686 teaches that reprographic devices include photocopiers and electronic printer, which are obviously capable of printing in bulk. It would have been obvious to one of ordinary skill in the art to use a bulk printer to output documents that may need wide dissemination particularly in the scheme of multiple authors and editors as taught by Z686 and Yamaguchi.

As per claim 17, Z686 teaches:

wherein the step of processing the electronic document includes invoking a software application (recognition software, col. 7, l. 66-col. 8, l. 4, col. 9, ll. 46-67) to process the electronic document.

As per claim 20, it recites substantially the same limitations as claim 1 above and analogous remarks apply.

As per claim 21, Z686 teaches:

wherein the processing unit processes the electronic document by one of sending by electronic mail (fig. 2a, 42) , printing (fig. 2a, elements 46, 48, 15 and 16), or copying (well-known to copy electronic files) of the electronic document.

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As per claim 22, it recites substantially the same limitations as claims 1 and 20 above and analogous remarks apply, except for the following, which is taught by Z686:

receiving a voice input indicative of an annotation (col. 6, ll. 44-49).

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Z686 and Yamaguchi, further in view of Daniele, US 544479.

As per claim 18, neither Z686 nor Yamaguchi teach using a mark based upon intellectual property rights associated with the document. However, Daniele teaches:

wherein the step of processing the electronic document includes identifying and processing based on any intellectual property rights associated with the hardcopy documents (col. 9, ll. 58-60, glyph codes that indicate copyright). It would have been obvious to one of ordinary skill in the art to use a display to present the document (glyph copyright management features of Daniele) to protect the authors of certain documents as taught by Z686 (fig. 5) and Yamaguchi.

As per claim 19, Z686 does not specifically allocating and calculating costs. However, Daniele teaches:

wherein the step of processing the electronic document includes calculating and allocating revenues or costs associated with the hardcopy document (survey results of prior art, figure 1 and "\$" in figure 7). It would have been obvious to one of ordinary skill in the art to use the glyphs of Z686 and Yamaguchi as the glyphs in Daniele to record, track, and allocate the accrual of copyright royalties.

Conclusion

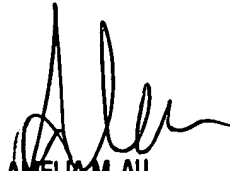
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U.S. patent(s) refer(s) to tracking hand gestures and movements in a document processing system: Kusunuki et al., 5732227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Miller whose telephone number is (703) 306-9134. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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June 20, 2003


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